

PATENT
Attorney Docket No. 52438.830009.US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mundell, Grover

Serial No. 10/710,813

Filed: August 4, 2004

For: SYSTEM AND METHOD FOR
MANAGING TRANSCRIPTS AND
EXHIBITS

Examiner: Ly, Cheyne D.

Art Unit: 2168

APPEAL BRIEF

Honorable Commissioner of Patents and Trademarks
Alexandria, VA 22313

Sir:

This is an appeal from the decision of the Examiner mailed on November 27, 2007 finally rejecting claims 1, 3-11, 13, 14 and 15-24.

REAL PARTY IN INTEREST

The real party in interest in this appeal is RealLegal, LLC, as evidenced by an Assignment filed at Reel 015821, Frame 0486.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences that are related to this case.

STATUS OF THE CLAIMS

Claims 1, 3-11, and 13-24 remain in this application.

This appeal is taken from the final rejection of claims 1, 3-11, and 13-24.

No claims are allowed.

STATUS OF AMENDMENTS

An Amendment and Response was filed on January 29, 2007 in response to an October 31, 2006 Office Action. A Notice of Non-Compliant Amendment was mailed on May 4, 2007, to which a response was filed on May 11, 2007. A Notice of Non-Compliant Amendment was mailed on May 17, 2007, to which a response was filed on May 25, 2007. A Notice of Non-Compliant Amendment was mailed on August 9, 2007, to which a response was filed on August 16, 2007 and a supplemental response on August 24, 2007. The Examiner submitted a Final Office Action on November 27, 2007. An Amendment After Final Rejection was filed on February 13, 2008. In a March 4, 2008 Advisory Action, the Examiner stated that the February 13, 2008 Amendment did not place the claims in condition for allowance.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is an independent claim, from which claims 3-11, 13 and 14 ultimately depend. The preamble of claim 1 is directed to a method of managing electronic transcripts and electronic exhibits performed on at least one processor. (Page 5, lines 16-20; page 6, lines 19-21). Claim 1 includes the step of selecting an electronic transcript file to establish an electronic link with at least one electronic exhibit. (Page 13, lines 3-14). The claim further requires synchronizing a media file with the electronic transcript. (Page 13, lines 15-22). In another step, claim 1 requires identifying at least one electronic exhibit to be electronically linked with the electronic transcript by a user defined electronic link. (Page 15, lines 3-23). Claim 1 also requires choosing a type of electronic link between the electronic transcript and the at least one electronic exhibit. (Page 15, lines 3-26). In another step, the claim requires inputting the user defined electronic link in the electronic transcript to establish the electronic link between the electronic transcript and the electronic exhibit. (Page 15, lines 1-26; page 16, lines 1-15). Finally, claim 1 recites the step of applying the electronic link to the electronic transcript.

such that the electronic transcript and the at least one electronic exhibit are linked to cause the at least one electronic exhibit to be automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link. (Page 15, lines 1-26; page 16, lines 1-26).

Claim 1 does not include any means-plus-function limitations pursuant to 35 U.S.C. § 112(6). Dependent claims 3-11, 13 and 14 likewise do not contain any means-plus-function limitations pursuant to 35 U.S.C. § 112(6).

Claim 15 is an independent claim, from which claims 16-24 ultimately depend. The preamble of claim 15 is directed to a system for managing electronic transcripts and electronic exhibits. (Page 5, lines 16-20; page 6, lines 19-21). Claim 15 recites that the system includes a transcript manager. (Page 8, lines 10-23). Claim 15 also requires an organizational and control module connected to the transcript manager to provide tools. (Page 12, lines 4-20). Claim 15 further requires a memory comprising at least one electronic transcript file, a media file associated with at least one of the at least one electronic transcript file, and at least one electronic exhibit file connected to the transcript manager. (Page 9, lines 12-24). Finally claim 15 recites a display connected to the transcript manager, the display providing at least a graphical user interface and at least one viewer, such that the transcript manager provides a graphical user interface and the organizational control module provides tools whereby a user can manage the at least one electronic transcript and the at least one exhibit to synchronize the media file with the at least one of the at least one electronic transcript file and input an electronic link in the at least one electronic transcript file linking the at least one electronic transcript with the at least one exhibit such that when the synchronized media file advances passed the electronic link, the linked at least one electronic exhibit is displayed. (Page 9, lines 25, 26; page 10, lines 1-18; page 11, lines 12-26; page 12, lines 1-3).

Claim 15 does not include any means-plus-function limitations pursuant to 35 U.S.C. § 112(6). Dependent claims 16-24 likewise do not contain any means-plus-function limitations pursuant to 35 U.S.C. § 112(6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner rejected claims 1, 3-11, and 13-24 under 35 U.S.C. § 103(a) as being unpatentable and obvious over United States Published Patent Application 2003/0078973 (“Przekop et al.”) in view of U.S. Patent No. 6,462,754 (“Chakraborty”).

ARGUMENT

A. Claims 1, 3-11, and 13-24 are patentable under 35 U.S.C. § 103(a) over United States Published Patent Application 2003/0078973 (“Przekop et al.”) in view of U.S. Patent No. 6,462,754 (“Chakraborty”).

Claim 1 recites a combination of elements including, for example, “inputting the user defined electronic link in the electronic transcript to establish the electronic link between the electronic transcript and the electronic exhibit; and applying the electronic link to the electronic transcript such that the electronic transcript and the at least one electronic exhibit are linked to cause the at least one electronic exhibit to be automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link,” which is not shown by the references either alone or in any reasonable combination thereof. Claim 15 recites a nearly identical limitation.

Przekop, et al. and Chakraborty are silent regarding automatically displaying the exhibit. As neither reference suggests or discloses automatically displaying the exhibit, they cannot render claims 1 or 15 obvious. To be sure, the portions of the references cited by the Examiner refer to the fact that “each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio

record . . ." Such a teaching is not the same or even similar to the cited limitation above, whereby "the exhibit is automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link." The cited reference at page 3, paragraph 0035, of Przekop et al. is simply incomplete and fails to teach the full nature of the claimed limitation. For at least this reason, claim 1 is not anticipated or obvious in view of Przekop et al. or Chakraborty either alone or in any reasonable combination thereof.

Moreover, Przekop et al. teach a system that synchronizes electronic video/audio records and corresponding electronic transcripts of the video/audio records. Accordingly, the transcripts are simply the same information as the video/audio records, but in different file formats. Claims 1 and 15 each are specifically related to operable electronic linking of "electronic transcripts" and "electronic exhibit files," which are specifically different terms relating to files containing different information. Again, the cited prior art fails to teach all of the claimed limitations of claims 1 and 15, let alone provide the requisite teaching or motivation to combine the claimed elements in the manner claimed herein.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). Courts and patent examiners should determine whether needs and problems known in the field and addressed by the prior art references can provide a reason for combining the elements in the manner claimed. KSR Intern. Co. v. Teleflex, Inc., No. 04-1350, 2007 WWL 1237837, at 4 (April 30, 2007). “In formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” Memo on KSR Decision to Examiners issued by the United States Patent and Trademark Office, May 4, 2007. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), see also In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002).

Claim 1 includes a combination of elements not disclosed or otherwise suggested within the art. The specific combination of elements are not found anywhere within the reference. Nor has the Examiner identified the reason why a person of ordinary skill in the art would have combined the prior art elements in the specific structural manner claimed. It has not been shown how such a system or methodology would be within the knowledge of one of ordinary skill in the art. To be sure, the cited references fail to teach systems that are configured for automatically displaying exhibits. Rather, the references teach that “each line of the transcript contains a selectable link to the video/audio record so that a permitted viewer, by simply selecting a link, is securely navigated to the corresponding portion of the video/audio record . . .” This is not relative to a limitation that requires that “the exhibit is

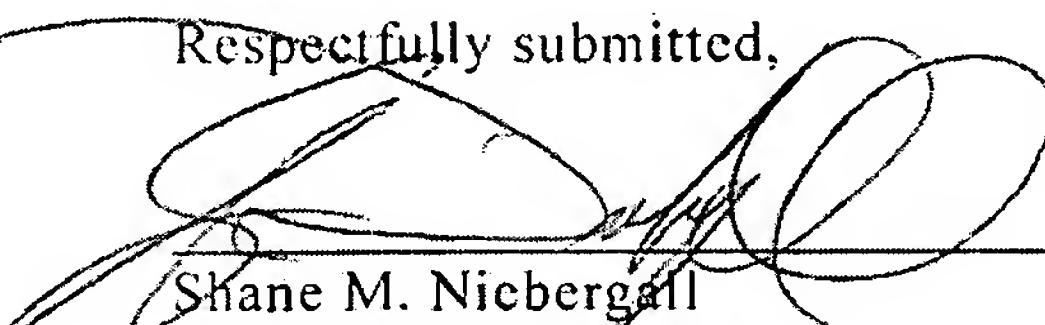
automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link.” Moreover, the references simply teach synchronizing electronic records and corresponding electronic transcripts or copies of the records. Again, this is quite different from the electronic linking of “electronic transcripts” and “electronic exhibit files.” Accordingly, a person of skill in the art would not look to such a reference on any objective basis when developing a methodology, such as that claimed.

Claims 3-11 and 13-24 each ultimately depend from either claim 1 or claim 15 and are believed to be allowable for at least the reasons set forth herein with respect to claims 1 and 15.

Request:

Reversal of the Examiner’s final rejection of claims 1, 3-11, and 13-24 under 35 U.S.C. § 103(a) over the Przekop et al. reference in view of the Chakraborty reference is respectfully requested for the above-stated reasons.

Signed this 15th day of April, 2008.

Respectfully submitted,

Shane M. Niebergall
Registration No. 44,974
ATTORNEY FOR APPELLANTS
HOLLAND & HART LLP
Post Office Box 8749
555 17th Street, Suite 3200
Denver, Colorado 80201
(303) 295-8034

CLAIMS APPENDIX

The Claims involved in this Appeal read as follows:

1. A method for managing electronic transcripts and electronic exhibits performed on at least one processor, the method comprising the steps of:
 - selecting an electronic transcript file to establish an electronic link with at least one electronic exhibit;
 - synchronizing a media file with the electronic transcript;
 - identifying at least one electronic exhibit to be electronically linked with the electronic transcript by a user defined electronic link;
 - choosing a type of electronic link between the electronic transcript and the at least one electronic exhibit;
 - inputting the user defined electronic link in the electronic transcript to establish the electronic link between the electronic transcript and the electronic exhibit; and
 - applying the electronic link to the electronic transcript such that the electronic transcript and the at least one electronic exhibit are linked to cause the at least one electronic exhibit to be automatically displayed as the electronic transcript and the synchronized media file are advanced passed the electronic link.
2. (canceled)
3. The method of claim 1, further comprising the steps of:
 - activating the applied electronic link; and
 - displaying the at least one electronic exhibit.
4. The method of claim 3, further comprising the steps of:
 - displaying the electronic transcript in a first window; and
 - displaying the at least one electronic exhibit in at least a second window.
5. The method of claim 3, wherein the step of displaying the at least one electronic exhibit comprises the step of displaying an image.
6. The method of claim 3, wherein the step of displaying the at least one electronic exhibit comprises playing an audio file.
7. The method of claim 3, wherein the step of displaying the at least one electronic exhibit comprises playing a video file.

8. The method of claim 3, wherein the step of displaying the at least one electronic exhibit comprises playing an audio/video file.

9. The method of claim 1, further comprising the steps of:
appending the media file to the electronic transcript.

10. The method of claim 9, further comprising the step of launching the media file in a media window.

11. The method of claim 10, further comprising the step of advancing the electronic transcript along with the media file.

12. (canceled)

13. The method of claim 1, further comprising the step of recognizing the characters of the at least one electronic exhibit to provide character searching of the at least one electronic exhibit.

14. The method of claim 1, further comprising the step of importing a file to a project, the file selected from a group of files consisting of electronic transcript files and electronic exhibit files.

15. A system for managing electronic transcripts and electronic exhibits, comprising:

a transcript manager;
an organizational and control module connected to the transcript manager to provide tools;

a memory comprising at least one electronic transcript file, a media file associated with at least one of the at least one electronic transcript file, and at least one electronic exhibit file connected to the transcript manager; and

a display connected to the transcript manager, the display providing at least a graphical user interface and at least one viewer, such that the transcript manager provides a graphical user interface and the organizational control module provides tools whereby a user can manage the at least one electronic transcript and the at least one exhibit to synchronize the media file with the at least one of the at least one electronic transcript file and input an electronic link in the at least one electronic transcript file linking the at least

one electronic transcript with the at least one exhibit such that when the synchronized media file advances passed the electronic link, the linked at least one electronic exhibit is displayed.

16. The system of claim 15, wherein the memory comprises a local memory connected to the transcript manager.

17. The system of claim 15, wherein the memory comprises at least a remote memory connected to the transcript manager through a network connection.

18. The system of claim 17, wherein the network is selected from a group of networks consisting of a local area network, a wide area network, an optical network, a wireless network, a WiFi network, an Ethernet, Internet, and World Wide Web.

19. The system of claim 15, wherein the memory comprises a removable medium.

20. The system of claim 19, wherein the removable medium is selected from the group consisting of a magnetic disk, an optical disk, and a tape.

21. The system of claim 15, wherein the graphical user interface receives user input from an input device selected from a group consisting of a keyboard, a mouse, a track ball, a light pen, and a touch screen.

22. The system of claim 15, wherein the display provides a first display to display the at least one electronic transcript and a second display to display the at least one electronic exhibit.

23. The system of claim 22, further comprising a media player to display media selected from a group of media consisting of audio, video, and audio/video.

24. The system of claim 15, further comprising at least one dialog box in which a user can enter a user defined association between the at least one electronic transcript and the at least one electronic exhibit.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.